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Paul W. Forney

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LEYDIG VOIT & MAYER, LTD  
TWO PRUDENTIAL PLAZA, SUITE 4900  
180 NORTH STETSON AVENUE  
CHICAGO, IL 60601-6731

EXAMINER

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1 RECORD OF ORAL HEARING  
2 UNITED STATES PATENT AND TRADEMARK OFFICE

3  
4 BEFORE THE BOARD OF PATENT APPEALS  
5 AND INTERFERENCES

6  
7 *EX PARTE* PAUL W. FORNEY, RASHESH MODY, DAVE TRAN,  
8 PRAMOD THAZHICHAYIL, VIJAY ANAND, and  
9 KIMSON Q. NGUYEN

10  
11 Appeal 2009-000054  
12 Application 09/955,473  
13 Technology Center 2100

14  
15 Oral Hearing Held: June 11, 2009

16  
17 Before HOWARD B. BLANKENSHIP, ST. JOHN COURTENAY, III, and  
18 STEPHEN C. SIU, *Administrative Patent Judges*.

19  
20  
21 APPEARANCES:

22 ON BEHALF OF THE APPELLANTS:

23 LEYDIG VOIT & MAYER, LTD  
24 TWO PRUDENTIAL PLAZA, SUITE 4900  
25 180 NORTH STETSON AVENUE  
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1           The above-entitled matter came on for oral hearing on Thursday, June  
2   11, 2009, at The U.S. Patent and Trademark Office, 600 Dulany Street,  
3   Alexandria, Virginia, before Victoria L. Wilson, Notary Public.

4  
5           JUDGE BLANKENSHIP: We are on the record now and you have  
6   20 minutes, sir.

7           MR. JOY: Okay. Honorable members of the Board, my name is  
8   Mark Joy, registration number 35,562, and I represent the Appellant Forney,  
9   et al., and the Assignee Invention Systems, Inc., in the present appeal  
10   application serial number 09/955,473 filed on September 17th, 2001.

11          In general, I believe the Appellant's Briefs are relatively clear with  
12   regard to what Appellants believe are the shortcomings of the current  
13   rejection of the presently pending claims 1 through 20. In particular, the first  
14   office action -- I'm sorry -- the final office action in the first instance does  
15   not provide, in our opinion, a sufficient reason for one skilled in the art to  
16   modify Khan in view of Wewalaarachchi in a way that would render  
17   Appellant's claimed invention.

18          And then in the second instance with regard to independent claim 8  
19   and dependent claim 5, we believe that the final office action rejection of  
20   those claims that recite data handlers or an extensible set of data handlers is  
21   inappropriate since the prior art references do not teach that particular  
22   element.

23          In particular, rather than showing an extensible set of particular -- of  
24   handlers which handle a particular type of data or how that data is handled,  
25   the references in the portions of Khan and Wewalaarachchi cited by the

1 office action identify an extensible set of sources of data. So it is a  
2 distinction between types of data, which is a data handler, and sources of  
3 data.

4 I won't repeat the summary of the various claimed inventions in the  
5 various independent claims because I think that's pretty well set out in the  
6 Briefs, as well. In fact, the primary reason for having -- requesting the oral  
7 hearing is that I would like to encourage and welcome any questions you  
8 have with regard to our positions and I'll do the best I can to explain those  
9 points in additional detail, if necessary.

10 In general, I guess the prior art -- I'll start by saying what our belief  
11 the prior art teaches. The Khan '678 patent --

12 I'm sorry -- application appears to disclose a user configurable  
13 information portal site that enables users to customize the portal by adding  
14 links to various public sites and HTML records and things of that sort, things  
15 which are in a standard format and can be easily incorporated through just  
16 very standard operations.

17 The final office action itself admits that Khan doesn't disclose or  
18 suggest the claimed customer configurable plant process observation portal  
19 that provides access to an extensible set of plant information sources and  
20 also agrees with Appellants, I believe, that Khan does not disclose an  
21 extensible set of data handlers for handling particular types of data.

22 On the other hand, Wewalaarachchi, the final office action and  
23 Answer states that Wewalaarachchi discloses a system that provides access  
24 to plant information and Appellants do agree that that is the -- that is, indeed,  
25 disclosed by Wewalaarachchi.

1 Turning to our argument, again, we submit that the final office action  
2 did not provide a sufficient rationale for modifying Khan in view of  
3 Wewalaarachchi to render the claimed invention. Our arguments with  
4 regard to the prima facie showing of obviousness are divided into two parts.

5 The first one, with regard to, for instance, claim 1 -- independent  
6 claim 1 and independent claim 10, is the absence of sufficient rationale to  
7 modify Khan in a way that would render the claimed invention. And, then,  
8 second, the absence of a teaching of a particular recited element in claims  
9 such as independent claim 8. And that's with regard to the extensible set of  
10 data handlers.

11 Regarding the second of the two points, that's the data handler issue,  
12 we believe that the element is simply not disclosed in Wewalaarachchi. The  
13 final office -- or I believe it is the final office action, I'd say that it is  
14 probably in the Answer, as well, cites column 7, lines 41 through 53 of  
15 Wewalaarachchi as teaching the extensible data handlers set.

16 It is our position that that's actually showing that an extensible set of  
17 data sources and that would distinguish from the definition that Applicants  
18 or Appellants have assigned to a data handler and, in fact, we have provided  
19 quite a bit of disclosure with regard to the data handlers and that's at figures  
20 20 through 22 of the application and it is associated written description. It is  
21 also shown in figure 2 as data handlers 130.

22 And so, as you can tell from the examples of data handlers, those are -  
23 - those are addressing the various types of information that are processed by  
24 this portal and enable users to connect to a variety of different types of  
25 information through this portal.

1 JUDGE COURTENAY: Is that what you mean by "extensible," that  
2 you can connect to a different variety of information?

3 MR. JOY: No. "Extensible" in the context of the data handlers means  
4 that you can actually add additional data handlers and it is shown in figure 2,  
5 just graphically, by the custom.

6 There is one, if you look at figure 2, custom is actually intended or is  
7 shown in the written description that goes along with it that you can add  
8 additional ones. So, as your system is expanded, you can define additional  
9 data handlers and add those to enable the processing of new types of  
10 information. And the figures 20 through 22 go into substantial detail of the  
11 methods and data structures that are associated with that data handler to  
12 enable the -- the extension of the system, handle new types of data.

13 And, again, that's in contrast to adding new sources of data, which  
14 might have -- which in the Wewalaarachchi system would have the same  
15 type of information but would be just a new source of data.

16 JUDGE COURTENAY: Okay. I have a question regarding what  
17 appears to be an admission on page 5 of the Reply Brief. Have you  
18 withdrawn your objection to the use of the Khan parent patent?

19 MR. JOY: Yes. Yes, I have. I have. That was as a result of the  
20 Answer and I don't know why the Examiner didn't just use the patent, it had  
21 an earlier priority date, but it would have made it easier and avoided that,  
22 but, yes, you are right.

23 JUDGE COURTENAY: Okay. So you are acknowledging that the  
24 Khan U.S. Patent 6,438,575 is prior art?

25 MR. JOY: With regard to the claims, yes. The portions of the

1 disclosure -- wait. I'm sorry. Did you say the patent or the application?

2 JUDGE COURTENAY: Well, we have the parent, the Khan patent  
3 application publication --

4 MR. JOY: Yes.

5 JUDGE COURTENAY: -- is a CIP of the Khan parent application,  
6 which is U.S. Patent 6,438,575.

7 MR. JOY: Right. And to address that, it is -- we have not attempted  
8 to swear behind. So for purposes of this appeal, that is true. On the other  
9 hand, I actually didn't think we would ever have to swear behind the  
10 reference. We believe that it wouldn't have rendered it invalid but, if  
11 necessary, we reserve that possibility following a continuation or RCE if that  
12 is necessary.

13 JUDGE COURTENAY: Okay.

14 MR. JOY: The second, which is the first point, is the -- is, basically,  
15 our argument that's already been fleshed out in quite a bit of detail in the  
16 briefs, that it is Appellant's opinion that the combination of the teachings of  
17 Khan and Wewalaarachchi just do not suggest the modifications that are  
18 necessary to render the claimed invention.

19 And, in particular, that -- Appellants believe that the system in Khan,  
20 which is directed to purely public documents, very standard format, HTML  
21 documents, just various public documents that are linked easily into a  
22 system, is very different than a system that's claimed as providing access to  
23 plant information and for the reasons that have been cited in the Brief  
24 already. It --

25 JUDGE COURTENAY: Well, you argue in the Brief that the plant

1 information is non-public and it is highly sensitive –

2 I'm looking at the top of page 8 of your Brief -- but that's not in your  
3 claim language.

4 MR. JOY: The language itself, that is true, but it does say plant  
5 information. Someone of ordinary skill in the art would know -- plant  
6 information itself is never public. That's all part of a closed system. That's --  
7 a process control system is shown, for example, in figure 1. And it is -- it is  
8 Appellant's position that a system that's configured to provide plant  
9 information is very different from the type that's shown in Khan.

10 JUDGE COURTENAY: Okay. I understand your position.

11 MR. JOY: Okay. Yeah, you know, I really don't feel like there is  
12 more that I could say and I would just be repeating what I have written in the  
13 initial Brief and the Reply Brief so I really -- I could just read it again. I  
14 don't think that would be a wise use of time.

15 As I said, I would like to answer any questions that you have but if  
16 there are none, I really don't have much to add beyond what's been briefed  
17 already.

18 JUDGE BLANKENSHIP: We have no further questions. Thank you,  
19 Mr. Joy. We are off the record.

20 (Discussion off the record.)

21 JUDGE BLANKENSHIP: Okay. We are on the record. You can  
22 proceed.

23 MR. JOY: Thank you. Am I on the record?

24 JUDGE BLANKENSHIP: Yes, we are on the record. You can  
25 proceed.



1           MR. JOY: Just in closing, I just want to reemphasize that there are  
2 differences between the independent claims. There is -- and I have tried to  
3 divide it into two parts. One of them -- and they have different arguments  
4 and I encourage and request your separate consideration of the two types,  
5 claim 8, in particular, which is directed to data handlers, and claim 1, which  
6 is directed to an extensible system that allows adding of new data sources.  
7 And with that I'll close.

8           JUDGE BLANKENSHIP: All right. Thank you, sir. We are off the  
9 record.

10           (Whereupon, the proceedings were concluded on June 11, 2009.)

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